

## REMARKS

Claims 1-49 are pending in the application. Claims 1-49 are rejected.

### Prior Art Rejections

Claims 1-12 and 16-28 are rejected as being anticipated and/or rendered obvious in light of Inoue (US 5,395,111).

Inoue describes mechanical reels having indicia displayed on the outer surface thereof with an innermost reel having its indicia able to be viewed through the outermost reel since the outer reel is transparent, allowing the gaming symbols of the inner reel to be seen through the outer reel, and therefore allowing a range of “combination” symbols to be formed.

There are several patentable distinguishing features between the present claimed invention and Inoue. First Applicant claims: a gaming console having an electronic display means. This is in contrast to the mechanical reels taught by the cited reference. The cited reference provides no teaching or suggestion of an electronic display means.

Second Applicant claims: a plurality of symbols are randomly selected and displayed on the electronic display means and wherein the first image component and the second image component are displayed on the same electronic display.

The Office Action admits that in Inoue “[T]he second set of symbols are fixed, static, have graphics in window.” This is different from applicant’s claimed invention where a plurality of symbols are randomly selected and displayed on the electronic display means.

Inoue teaches in col. 3 lines 50-54 that the order of disposing symbols on the outer reel is fixed. The Figs. also show the inner reel is fixed.

The prior art teaches the second set of images is fixed while in contrast applicant's first image and a second image component are randomly selected.

Also, nowhere does Inoue teach first image component is visible through the second image component. Inoue does not describe the one symbol seen through the other symbol as asserted in the Office Action.

What the Abstract of Inoue states is "The outer reel has a transparent outer circumferential frame to allow a player to see symbols of the inner reel." Further Inoue describes in the Abstract the combined symbol of superimposed inner and outer reel symbols is produced. Therefore Inoue teaches producing a combined symbol composed of the outer symbol and the inner symbol which is seen through the transparent outer circumferential frame of the outer reel.

This is supported by the Figs of Inoue and col. 4, lines 51-54 the inner reels and moving symbols can be observed through transparent outer circumferential frames of the outer reels. Further col. 4, lines 30-34 "The symbols on the outer reels 5a to 7a which move downward can be observed, and those on the inner reels 5b and 7b which move upward can be observed through the transparent outer reels 5a to 7a." Again nowhere does Inoue teach first image component is visible through the second image component.

The images on the reels in Inoue are fixed and are not able to be randomly selected and displayed on a display means as in Applicant's claims 1-12 and 16-28. There is no disclosure of a second image component that displays non-basic image features that are additional to the game features of the first image component and where the second image component is superimposed on the first image component.

In the present invention there is a base game screen that displays all the basic game functionality, that is a first image component which displays basic game features. The basic game screen is still seen through the transparent sprite and therefore does not block the players view of any critical game information such as the symbols displayed on reels. This differs from Inoue as previously argued because the two reels in the Inoue patent just display components of the basic game, and the second reel displays its symbols through a transparent portion of the reel and not through the first image.

#### BENNETT

Claims 13, 29 and 32 to 47 as obvious over Inoue in view of Bennett.

Bennett discloses an animated wild card invoked when a special triggering combination of symbols occurs. Accordingly, on the basis that the above arguments, it is respectfully submitted that the claims are allowable over Inoue and Bennett. Bennett is also different from at least claims 13, 29 and 32 to 47 for the following reasons:

The wild symbol of Bennett moves to different symbol locations on the screen as a part of the basic game and there is nothing in this Bennett to suggest that it is transparent as claimed by applicant.

That is, Bennett does not teach nor suggest the first image component is visible through a second image component. In Bennett the moving wild symbol, penguin example in Bennett, moves from a first portion of the screen, being the top left corner and moves through fifteen different positions to replace an original symbol. Once it moves from that position the original symbol is again displayed. When the moving wild symbol has finished its path a determination of how much a user wins is made and then displayed. As mentioned, the symbol that is covered

by the moving wild symbol is totally removed while the wild symbol is in its position. Bennett teaches away from transparency.

#### OKADA

Claims 14, 15, 30, 31, 48 and 49 are rejected as being obvious over Inoue in view of Okada.

Okada, column 5, lines 55-65, does not disclose the features of the claimed invention and merely indicates win lines on a liquid crystal panel arranged in a three by three symbol matrix that under different conditions is either in a lit state or an unlit state.

The teaching in Inoue specifically relates to identifying effective winning lines on which a winning symbol array appears and this is done by optical means.

There is no suggestion that the second image component is transparent such that a first image component is visible through the second image component under the control of control means and no suggestion of displaying a first image component which displays basic game features and a second image component that displays non-basic image features that are superimposed on the first image component.

Also there is no suggestion of a game control means arranged to control images displayed on an electronic display means such that a plurality of symbols are randomly selected and displayed and the first image component and the second image component are displayed on the same electronic display.

Most importantly, it is respectfully submitted there is no suggestion that a person skilled in the art would arrive at the invention claimed by combining the teachings of Inoue, Bennett and Okada. Given that all of the claims refer to the transparency of the second image component and there is no mention of this in either of Bennett or Okada and given that Inoue simply has two

mechanical reels one of which is able to be seen through a portion of the other and it only relates to one game played, one skilled in the art could not arrive at the claimed invention.

Further one skilled in the art would not likely make such combination of the three references because such a combination would likely destroy the intended function of each of the references. For example in relation to Bennett one skilled in the art would not be led to make the wild card transparent because if the wild symbol in Bennett were made to be transparent then when it moved to a symbol position the existing symbol would be viewable through the wild symbol. Hence the original symbol would still be seen which would be a problem when calculating the wins for the game and its concept would be destroyed. That is, when the wild symbol moves to a symbol position, then wins including the wild symbol are paid, but if the underlying symbol could be seen and could create different winning combinations it would be a problem. That is it would either be misleading to the player or it would require a change to the mathematics of the game resulting in the game working differently to the Bennett invention.

It is respectfully submitted that all of the citations teach away from the invention. For example, as stated above the wild symbol in Bennett cannot be transparent as it would change the game and therefore Bennett teaches towards an opaque symbol. Inoue and Okada on the other hand teach the use of two separate display means by using physical layers which teach away from the invention where two images appear on a single display means.

The present invention solves the problem of critical game information being blocked by opaque foreground animations. Bennett on the other hand is merely a single game concept, Okada solves the problem of how to indicate win lines on a mechanical stepper machine and Inoue is a style of game for a mechanical stepper machine, all of which have for their purpose different problems to solve.

For at least the foregoing reasons it is respectfully submitted there is no suggestion which would lead one skilled in the art to make such a combination of prior art. Thus even if all the elements were present in the cited references, it is well-established that a combination of limitations, some of which separately may be known, may be a new combination of limitations which is nonobvious under the condition of 35 U.S.C. 103.

Moreover, “an examiner may often find every element of a claimed invention in the prior art.” *In re Rouffet*, 47 USPQ3d 1453, 1457 (Fed. Cir. 1998) (reversing PTO obviousness rejection based on lack of suggestion or motivation to combine reference). Therefore even if every element of a claimed invention is in the combined prior art there must be some suggestion or motivation to combine the references. “Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form must nevertheless be ‘clear and particularity.’” *In re Dembiscak*, 175 F.3d 994, 999 (CAFC 1999).


The only such suggestion provided has been from applicant’s own disclosure.

For at least the foregoing reasons it is respectfully submitted the rejections of claims 1-49 should be withdrawn.

In view of the remarks set forth above, this application is in condition for allowance which action is respectfully requested. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

Any fee due with this paper may be charged to Deposit Account No. 50-1290.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Brian S. Myers", is written over a horizontal line.

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